

Browne & Woods LLP

MEMORANDUM

STATE BAR OF CALIFORNIA INTELLECTUAL PROPERTY SECTION TRADE SECRET COMMITTEE

November 5, 2004 Meeting Minutes

The Trade Secrets Committee held an in person meeting in conjunction with the Intellectual Property Section's annual IP Institute. The following are the minutes of that meeting

1. **Attendance.** The following Committee members attended the meeting: Ben Scheibe, Joanna Mendoza, Bec Edelsen, Randy Kay, David Shaub, Sophia Park, Jennifer Brockett, Thérèse Keelaghan, Vice-Chair David Morales, and Kevin Cahill. Jim Pooley participated by telephone

2. **Update On Trade Secrets Treatise.** Randy Kay and Bec Edelson updated Committee members on the progress of the Trade Secret treatise edited by and written by members of the Committee. It is anticipated that the treatise will be promoted at the November 2004 IP Institute and published in the first quarter of 2005.

3. **Upcoming programs.** The members discussed upcoming programs, which included:

- a. **IP Institute – November 4-6, 2004** -- Disney's Grand California Hotel -- Bec Edelsen, Randy Kay, and the Honorable Mark Snauffer (Fresno Superior Court) were scheduled to speak on trade secret issues during the annual IP Institute.
- b. **February 10, 2005:** A lunch program developed by Bec entitled "*Protecting Your Business From Departing Employees*" will be held February 10, 2005 at Alschuler Grossman Stein & Kahan.
- c. **November 2005:** IP Institute is seeking trade secret program.

4. Speaking Opportunities/Writing Opportunities.

The Committee members discussed potential writing and speaking opportunities. The members also discussed the need for the Committee to keep a flow of articles to *New Matter*. John Yates and Ben Scheibe have articles in progress. Members interested in writing an article (from 1500 to 6000 words) should e-mail Ben with a proposed topic and target date so that Ben may reserve the topic with *New Matter* and coordinate the flow of articles from the Committee. Members are encouraged to take briefs or research memoranda from their practice and turn these into articles if the topics are of interest to the trade secret or IP community.

5. Plain English Trade Secret Jury Instruction Project. As mentioned in prior minutes, a subcommittee has been established, consisting of Ben Scheibe, Carolyn Sieve, Randy Kay, Marshall Lerner, Bec Edelson, and Robert Freitas. Robert Freitas has volunteered to head the Committee and to act as a clearinghouse to collect instructions from Committee members. Although Robert has received a few instructions, he has asked for additional instructions from Committee members. All Committee members are encouraged to provide trade secret instructions they have found useful in the past to Robert Freitas:

RFreitas@Orrick.com

6. New Project(s).

- a. **Website:** The "Frequently Asked Questions" page on our Committee's website is somewhat out of date. Committee members are asked to review the page with

an eye towards updating the pages and making them more user friendly. Vice Chair David Morales will head up this project and additional volunteers are needed. Volunteers should e-mail David (dmorales@lgpatlaw.com) and suggestions for website improvements can be e-mailed to David as well or submitted at the next meeting. Our current pages may be viewed at:

http://www.calbar.ca.gov/state/calbar/calbar_sections_generic.jsp?sImagePath=Intellectual-Property-Section_with-right-menu.gif&sCategoryPath=/Home/Attorney%20Resources/Sections/Intellectual%20Property%20Law/Standing%20Committees/Trade%20Secrets&sAdsPath=sectionsads/IP_Cmte_Secrets_Home.html&sFileType=HTML&sRightMenuPath=sectionsrightmenu/IP_Cmte_Home-Page.html&sCatHtmlPath=html/IP_Cmte_Secrets_Home.html

- b. **CLE By Phone:** The members further discussed the idea of the Committee hosting telephonic CLE programs on trade secret related topics. The programs would be one hour; participants would participate by phone and receive CLE credit through the State Bar. There seems to be sufficient interest among committee members and Committee members were asked to think about potential topics and speakers.
- c. **Legislative Reform:** Interest was expressed in seeking legislative reform on issues of interest to trade secret practitioners. One such issue is the possible abuse of the litigation process by asserting spurious claims of trade secrets in order to obtain access to a competitor's confidential information. Joanna Mendoza circulated a draft identifying the issue and a possible remedy through the amendment of CCP § 2019(d). Other ideas were also expressed and an ad hoc sub-committee was formed to discuss ideas.

7. **Next Meeting.** The Trade Secret Committee will have its next telephonic meeting on January 18, 2005 at 3:00 p.m. Ben will circulate call-in information in advance of the meeting.